

### **REMARKS**

Reconsideration of this Application, as amended, is respectfully requested. Applicant has addressed every ground for rejection in the Office Action set forth in Paper No. 3, and believes the Application is now in condition for allowance.

To more clearly describe the present invention, independent Claims 1, 13 and 19 have been amended, and new Claims 24 and 25 have been added.

“Real Time” as used herein refers to the interactive input of a request for information and the instantaneous response that answers the request – not just a message that the request was received or that an answer will follow.

The present invention of Claim 1 as amended, relates to a system for determining eligibility of a participant by a dental care provider for determining plan design as well as for recording utilization of benefits by that participant. The eligibility of the participant is determined *in real time* and the utilization of benefits is also recorded in real time.

The present invention of Claim 13 as amended, comprises the method of providing information to the dental care provider regarding the participant by way of the following steps: determining the eligibility of the participant by: inputting an identifier data pertaining to at least one participant as input; searching for the identifier data in data storage means; providing output in the form of data provided *in real time*, pertaining to the eligibility of the participant with respect to a necessary procedure; and, recording *in real time*, the utilization of benefits by way of a procedure by the dental provider in the following steps: inputting identifier data pertaining to the participant as input; and inputting the performed procedure data.

Likewise, Claim 19, as amended, provides a method for establishing a network for the administration of coverage with respect to a dental insurance plan comprising the steps of: providing a computer network; storing the data pertaining to a participant and to the coverage plan pertaining to the participant; providing access to the data of the participant from at least one of the computers so as to: determine the eligibility of the participant for a particular procedure *in real time*; and/or recording the utilization of participant benefits by the dental care provider to form utilization records *in real time*.

Claims 1-3, 5, 7-9, 12, 13, 16, 19 and 21 stand rejected under 35 U.S.C. §102(a) as being anticipated by Spurgeon, U.S. Patent No. 5,890,129. Claims 10, 11, 14, 15, 20, 22 and 23 stand rejected under 35 U.S.C. Section 103(a) as unpatentable over Spurgeon, U.S. Patent No. 5,890,129. In addition, Claims 4, 6, and 17-18 stand rejected under 35 U.S.C. 103(a) as unpatentable over Spurgeon '129 in view of Moore et al., U.S. Patent No. 5,930,759. Applicant respectfully traverses these rejections.

Spurgeon '129 is a particular system for exchanging health care insurance information using *push technology* to send subscriber insurance data out over the Internet to the computer operated by the health-care provider of each subscriber.

In particular, as explained in Spurgeon '129 the push method begins with the mandatory installation of a specific and proprietary push technology reader as a client software application, which is used by the server to identify the client on the network. The application presents the information to the user. The client also uses this application as a subscribing device to order automated information. The user of the client application

enters requests for specific classes of information and the preferred frequency of updates. (Col. 7 ll. 54-60).

After receiving this user specific information, the server fashions a response based on the inherent features of the server application and the user requests. The server then *pushes* the customized information across the network to the client, hence the name *push technology*. (Col. 7 ll. 61-65).

As further explained in Spurgeon '129, push technology attempts to provide up-to-date data to the provider interface computer, by pushing the data out to the provider interface computer and into a provider database therein, rather than requiring the provider to pull the data back down from the information – exchange server. (Col. 7 ll. 66 - Col. 8 ll. 4). Such push technology is used in all situations by Spurgeon '129 to broadcast subscriber insurance data to the provider. A major object of Spurgeon '129 is purportedly that the provider is being kept “up-to-date” on patient/subscriber status without any direct intervention on the part of the provider. (Col. 8 ll. 51-57).

It is precisely this ability on the part of the healthcare provider to *directly intervene* with respect to Applicant's system and access participant eligibility data *in real time*, as well as to update utilization of benefits data *in real time* that sets Applicant's system apart from the push technology system of Spurgeon '129. As previously explained, “Real Time” as used herein refers to the interactive input of a request for information and the instantaneous response that answers the request – not just a message that the request was received or that an answer will follow. As a push technology system, Spurgeon '129 is

simply incapable of providing such eligibility or benefits utilization information to the provider in “real time”.

Push servers have to initiate the connection with the client/provider and generate such new data according to their own schedules. Such servers cannot push data to client/providers that connect to the network only occasionally. Hence, a provider is either on the Internet constantly or is dependent on the server’s schedule for such data transfers and thus by definition cannot access such eligibility information from the server or update utilization information in “real time”. As a result, there could be a considerable delay between the time when eligibility information is requested and when such current information is finally received from the server. Hence, in the interim, the eligibility and utilization information on the provider’s system may not be current, depending upon when the last data transfer was pushed by the server. Moreover, security issues are created by such server initiated data transfers. The Spurgeon system operates like a series of discrete one-way communications without the ability to interact during each communication. In Applicant’s system, such interaction is not only possible, but encouraged.

Spurgeon ‘129 requires the installation of special software at the client/provider (Col. 7 ll. 53-56), as well as specific LAN Software at the insurer end of the System. Such increased processing at the insurer end of the system further prevents the providing of such information in real time. In further contrast to the system of Spurgeon ‘129, Applicant’s system does not require any such special software at either end of the System.

Indeed Applicant's system can receive data in real text format. No LAN Software is needed. Moreover, the Internet is engaged only as needed.

Hence, in light of these and other differences, Spurgeon '129 fails to teach or suggest, among other things, the capability of the Applicant's system to provide access to participant eligibility information and/or updating of utilization of benefits by the provider in real time, as claimed in independent Claims 1, 13, and 19. As a result, Applicant respectfully submits that the rejection of Claims 1, 13 and 19 under 35 USC §102(a) as being anticipated and/or obvious under 35 USC §103(a) by Spurgeon '129 and/or Moore '759 should be withdrawn. Inasmuch as: Claims 2 - 12 depend from Claim 1; Claims 14 - 18 depend from Claim 13; and Claims 20 - 23 depend from Claim 19, and serve to further limit same, they should likewise be deemed allowable.

The Examiner notes that the system of Spurgeon '129 is networked to the Internet. The Examiner takes Official Notice and asserts that it is well known to use the Internet to access data in real time. The Examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate this well-known teaching into Spurgeon '129, to supposedly allow access to inputted performed procedure data in real time. Applicant traverses this rejection and expressly requests that the Examiner cite any prior art that discloses any teaching or suggestion of providing eligibility information or benefit utilization information in real time in a dental, healthcare environment. In the absence of any such cited prior art, Applicant submits that the taking of such Official Notice is improper and should be withdrawn.

As shown by Spurgeon '129 itself, merely using the Internet does not mean that the information requested will be provided in real time. While a request for information may perhaps be made by a user, sent over the Internet and received by a server in what appears to be "real time", real time interaction means that the entire transaction (i.e. the question and answer) are provided immediately – not just an acknowledgment that the request was received or a message that an answer will be provided. As explained above, Spurgeon '129 is incapable of doing so.

Therefore, the Examiner's taking of Official Notice as to use of the Internet automatically signifying the providing of information in real time should be withdrawn. Moreover, as explained above, it would not have been obvious, to one of skill in the art, at the time of the invention, to incorporate access to inputted data or to update data in real time into the Spurgeon '129 system. Not only is there no suggestion in Spurgeon '129 for doing so, but its teaching of push technology and its inherent object of preventing clients from initiating contact with the server to pull down updated information would be frustrated.

Similarly, Applicant respectfully requests that any prior art be cited which teaches or suggests the features of limiting access to sensitive data to only authorized personnel only, together with the other claimed features of Applicant's claimed system. In the absence of any such cited prior art, the Official Notice should be withdrawn as well.

Neither does combining Spurgeon '129, if such combination were even possible, with Moore U.S. Pat. No. 5,930,759 result in a system having the claimed capabilities of Applicant's system.

Moore '759 discloses a system for assembling, filing and processing healthcare data transactions electronically. While the Moore '759 system can inquire electronically about patient eligibility and policy benefits, a clearinghouse processes that claim or transaction and sends it on to the patient's insurance company or other healthcare payor to determine various items of information such as eligibility, policy benefits, claim dates, a payment amount and the names of the payor and payee. (Col. 5 ll. 14-24). However, Moore '759 fails to teach or suggest among other things, the real time access to eligibility and updating of benefits utilization information features of Applicant's system. Hence, there is simply no suggestion for combining Moore '759 and Spurgeon '129. Even if one were somehow nevertheless able to do so, Applicant submits that the resulting combination would still lack the real time access to eligibility verification and updating of benefit utilization features of the Applicant's claimed system. Accordingly, Applicant respectfully submits that the rejection of Claims 4, 6 and 17-18 under 35 USC §103(a) as unpatentable over Spurgeon '129 in view of Moore et al. '759 should be withdrawn as well. Applicant herewith submits new drawings which are believed to overcome the Examiner's objection thereto.

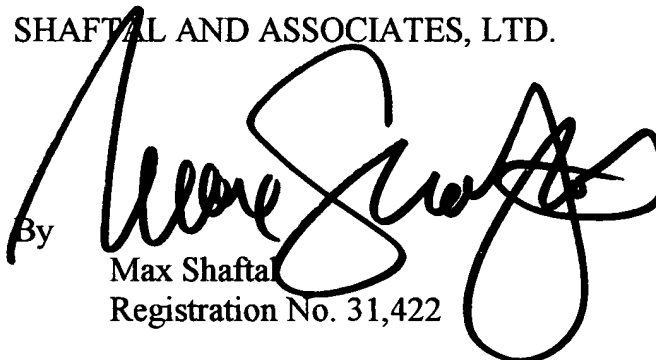
Applicant submits that in view of the above-identified amendments and supporting remarks, the claims in their present amended form are patentably distinct over the cited prior art. Allowance of the new claims and the remaining rejected claims, as amended, is respectfully requested.

Should the Examiner discover that there are remaining issues which could be resolved by a telephone or personal interview, he is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Dated: June 8, 2001  
Shaftal and Associates, Ltd.  
300 South Wacker Drive  
Suite 3000  
Chicago, Illinois 60606  
Telephone: 312-913-1800  
Facsimile: 312-913-1813

Respectfully submitted,

SHAFTAL AND ASSOCIATES, LTD.

By   
Max Shaftal  
Registration No. 31,422



MARKED-UP VERSION OF AMENDED CLAIMS

1. (Amended) A system for determining eligibility of a participant by a dental care provider for determining plan design [by a dental care provider] and for recording utilization of benefits by a dental care provider for a participant comprising:

- at least one computer, each such at least one computer having at least one data storage means, at least one input means, and at least one output means, the at least one computer having participant data stored on the data storage means pertaining to a participant;

- means associated with the at least one computer for determining eligibility of the participant in real time; and

- means associated with the at least one computer for recording utilization of benefits by the dental provider in real time.

13. (Amended) A method for providing information to dental care providers regarding a participant comprising the steps of:

- determining eligibility of the participant comprising the steps of:
  - inputting an identifier data pertaining to at least one participant as input;
  - searching for the identifier data in said participant data of a storage means;
  - providing output in the form of data provided in real time pertaining to the eligibility of the at least one participant; [with respect to at least one procedure necessitated by the at least one participant, and]

- inputting a procedure code in real time to determine whether the code is covered by the participant's plan; and

- recording the utilization of benefits and claims in real time by way of a procedure by the dental care provider comprising the steps of:

- inputting an identifier data pertaining to at least one participant as input;

and

- inputting a performed procedure data.

19. (Amended) A method for establishing a network for the administration of coverage to a dental care provider comprising the steps of:

- providing a plurality of computers;
- linking the computers to form a network;
- storing data pertaining to a participant and to a coverage plan pertaining to the participant; and

- providing access to the data of the participant from at least one of the plurality of computers, to in turn, facilitate at least one of:

- determining in real time the eligibility of the participant for a particular procedure; and

- recording the utilization of participant benefits by the dental care provider in real time to form utilization records.

24. (New) The method of Claim 19 wherein said network is permanent.

25. (New) The method of Claim 19 wherein said network is transient.